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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/977,915 11/25/97 VERNER P 1267/13

ADAMS LAW FIRM
2180 FIRST UNION PLAZA
CHARLOTTE NC 28282

QM12/0809

EXAMINER

FALIK, A

ART UNIT

PAPER NUMBER

3741

11

DATE MAILED: 08/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/977,915

Applicant(s)
Verner et al

Examiner
Andy Falik

Group Art Unit
3741



☒ Responsive to communication(s) filed on Mar 12, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 20-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 20-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Miscellaneous

The 3/12/99 Supplemental Amendment is effective in overcoming the 37CFR 1.121(b) rejection to claim 21.

Recapture Rule

Claims 20-23 improperly seek to recapture subject matter surrendered during the prosecution of the Verner et al patent. During prosecution of the patent with respect to which the reissue application was filed, patentee argued that certain limitations of the claims distinguished over the prior art.

Initially it is noted that although the words "downwardly directed" were always in patent claim 1, even as originally filed, this limitation was argued as giving patentability to claim 1 to overcome the "Report" reference - see page 7 of the amendment filed August 17, 1994 (paper No. 14 in the patent). In this regard, see Hester Industries v. Stein Inc., 46 USPQ2d 1641, 1649 (Fed. Cir., 1998). Applicant has surrendered subject matter which does not claim this feature. Since claims 20-23 do not recite "downwardly directed," claims 20-23 violate the recapture doctrine.

Reissue claims 20-23 also delete (from patent claim 1) "toward the threads of the warp". Although this feature was not added by amendment during prosecution of the patent, it was argued to impart patentability to claim 1 and distinguish over the prior art applied in the rejection

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of that claim. It was argued as essential to overcoming the rejection (which was based on the aforementioned Report reference) . Again, see page 7 of the amendment filed August 17, 1994 (paper No. 14 in the patent). In this regard, see Hester Industries v. Stein Inc., 46 USPQ2d 1641, 1649 (Fed. Cir., 1998). Applicant has surrendered subject matter which does not claim this feature.

Conclusion

Claims 20-23 are rejected for the reasons stated above under the equitable "recapture" doctrine - see *In re Clement*, 45 USPQ2d 1161 (Fed. Cir 1997), and Hester, cited above.

Any inquiry to the merits of this office action or to any specific features of this communication or earlier communications from the examiner should be directed to Andy Falik whose telephone number is (703) 308-1283. The examiner can normally be reached on Monday-Thursday from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Calvert can be reached on (703) 305-1025. The fax phone number for this Group is (703) 305-3588.


**ANDY FALIK
PRIMARY EXAMINER
GROUP 3741**

AMF
August 3, 1999